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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,595

09/05/2003

Paul R. Amtson

BING-I-1038

7958

25315

7590

03/27/2006

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EXAMINER

SCHINDLER, DAVID M

ART UNIT

PAPER NUMBER

2862

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,595

Applicant(s)

ARNTSON, PAUL R.

Examiner

David Schindler

Art Unit

2862

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-26, 28-45 and 47-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-26, 28-45 and 47-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

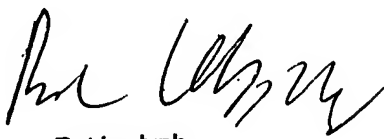
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Bot Ledyne  
Primary Examiner

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>page 3 of 12/23/03</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the communication received on 1/03/2006.

#### ***Information Disclosure Statement***

2. With regard to the first paragraph on page 2 of Applicant's Remarks, the Examiner notes that page 3 of the Information Disclosure Statement (IDS) submitted 12/23/2003 has been included with this action. Reference number 34, which was DE 508 647, has been amended to DE 508 347. Reference DE 508 347 has been considered. The Examiner notes that references listed on the IDS that were previously considered have been crossed out.

#### ***Specification***

3. The amendment filed 1/03/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The Examiner notes that Figures 1 and 2 now disclose an Electromagnet in place of a Magnet. Figures 1 and 2 of the drawings originally submitted did not disclose an electromagnet.

The Examiner notes that Figure 2 now includes a circular item that was not disclosed in the originally disclosed Figure 2.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10, 12-26, 28-45, and 47-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to Claim 1,

6. Claim 1 now requires a shaped magnetic field portion including an approximately partially-spherical portion at least extending through the workpiece (see lines 5-6).

Lines 9 and 11 also recite an approximately partially-spherical portion. It is noted to applicant that the above feature does not appear to have been disclosed in the original disclosure. The third full paragraph of page 4 of the specification for example discloses an approximately spherical shape, but not an approximately partially-spherical portion.

Also note Figure 1 and canceled claim 11.

Furthermore, the Examiner notes that Claim 1 appears to further introduce matter that was not originally disclosed when the dependent claims are considered. An example of this issue is that the original disclosure does not appear to disclose an electromagnet in combination with an approximately partially-spherical portion as seen with the combination of claims 1 and 3.

As to Claim 21,

A similar issue to that mentioned in the above paragraph 6 exists with Claim 21.

As to Claim 35,

A similar issue to that mentioned in the above paragraph 6 exists with Claim 35.

7. Claims 1-10, 12-26, 28-45, and 47-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to the above claims, the Examiner notes that applicant claims, for example, a first portion including a magnet having a magnetic field emanating therefrom and at least one field-directing member configured to provide a shaped magnetic field portion of the magnetic field, the shaped magnetic field portion including an approximately partially-spherical portion on lines 3-6 of Claim 1. The Examiner notes, however, that no field-directing member in the original disclosure appears to provide a shaped magnetic field portion of the magnetic field including the above mentioned approximately partially-spherical shape, or any of the shapes shown in the figures. Rather, the field-directing portions appear to provide a magnetic field, such as the field shown in Figure 1, around which the applicant has drawn a geometric figure. The Examiner notes, for example, that the magnetic field disclosed in figure 1 does not include a spherical or approximately spherical portion in the area around which

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applicant has drawn the geometric figure. Note the magnetic field line pattern. The same is true of the other magnetic fields disclosed in the other figures of the invention. A person of ordinary skill in the art would not know how to provide a shaped magnetic field portion including an approximately spherical or approximately partially spherical portion, or any other shape shown in the drawings, given the original disclosure.

### ***Response to Arguments***

8. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Schindler whose telephone number is (571) 272-2112. The examiner can normally be reached on M-F (8:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on (571) 272-2180. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Schindler  
Examiner  
Art Unit 2862

DS